

**AMENDMENT TO THE DRAWINGS:**

Please REPLACE Figures 1-4 with the enclosed Figures 1-4 (Replacement Sheets 1-2).

**REMARKS**

In the Pending Application, Claims 1-21 have been rejected and Claims 15-17 have been objected to. Via this Amendment and Response to Final Office Action, Claims 1-3, 5, 6, 8, 9, 12 and 15 have been amended. Therefore, Claims 1-20 are currently pending. Further, the specification, abstract and drawings have been amended. No new matter has been introduced by the amendments and support for the amendments is found in the application as filed.

**I. Objections to the Specification**

The Examiner has provided a reminder of the preferred layout for the specification of a utility application. The specification has been amended to include section headings indicating the Title of the Invention, Cross-Reference to Related Applications, Background, Summary, Description of the Drawings, and Detailed Description. The section headings are in upper case, without underlining or bold type. It is respectfully submitted that 37 CFR §1.77 does not require that section headings be used when there is no applicable text, and thus headings that are not used have not been added. Further, as mentioned by the Examiner, the section headers presented in the Office Action are merely suggestions. There is no requirement that the exact wording presented in the suggested headings be used.

In addition, the Examiner has objected to the specification as failing to mention in the first paragraph of the application the continuing data of the parent application. The specification has been amended to include a Cross-Reference to Related Applications and a statement that the Pending Application is a national phase application of PCT/GB03/02546, which claims priority to Great Britain Patent Application No. GB 0213555.6, filed on June, 13 2002.

The Pending Application was filed under 35 USC §371 as a nationalization in the US of a prior-filed PCT application, which claims priority to Great Britain Patent Application No. GB 0213555.6, filed on June, 13 2002. The Office accepted the Pending Application under 35 USC §371 and the priority claim, as stated in the Notice of Acceptance of Application under 35 USC §371 and 37 CFR §1.495 mailed by the Office on August 5, 2005. It is therefore respectfully submitted that the priority claim to Great Britain Patent Application No. GB 0213555.6 falls

under 35 USC §119(a) that governs claims of foreign priority, and not 35 USC §120 that governs a benefit claim to a US or PCT application. There is nothing under 35 USC §119(a) that requires a foreign priority claim to be included in the specification. However, the specification has been amended to include a statement regarding the related applications to emphasize the priority claim. It is therefore respectfully requested that the objection be withdrawn.

## **II. Objection to the Abstract**

The Examiner has to the abstract because it (A) does not commence on a separate sheet of paper; (B) is longer than 150 words; and (C) includes language describing extensive mechanical and design details, which mimics the language of the claims. The abstract of the Pending Application has been amended to include no more than 150 words and to improve its readability. A clean copy of the abstract commencing on a separate sheet and including the amendments is enclosed with this Amendment and Response. Thus, the abstract complies with the formatting requirements. Therefore, it is respectfully requested that this objection be withdrawn.

## **III. Objection to the Drawings**

The Examiner has objected to the drawings as failing to comply with 37 CFR §1.84(p)(5) because they do not include the following reference signs that are included in the specification: "curved wall 28" and "proximal end 42." Replacement sheets are enclosed that include these reference numbers. Therefore, it is respectfully requested that this objection be withdrawn.

## **IV. Objection to Claims 1-3, 5, 6, 9, 12 and 15**

The Examiner has objected to Claims 1-3, 5, 6, 9, 12 and 15 because these claims use phrases that include the word "means" but do not specify a function in the preceding words. Claims 1-3, 5, 6, 9, 12 and 15 have been amended to replace "spring means," "guide means," "locking means," and "groove means" with --spring--, --guide--, --lock-- and --groove--, respectively. It is therefore respectfully requested that the objection be withdrawn.

**V. Rejection of Claims 1, 2, 4, 9-13, 15 and 19 under 35 U.S.C. § 102(b)**

The Examiner has rejected Claims 1, 2, 4, 9-13, 15, and 19 under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 4,813,940 ("Parry").

"A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently in a single prior art reference." *MPEP* §2131; *Verdegall Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

It is respectfully submitted that the Examiner has failed to set forth a prima facie case of anticipation because Parry does not teach all the limitations of Claims 1, 2, 4, 9-13, 15, and 19. Particularly, Parry does not teach the following: a second guide part operative on movement by the manual relative rotation of the first and second members. Further, with regard to Claims 9-11, the Examiner has failed to show that these Claims are anticipated by a single reference.

Parry teaches a protective sleeve for surrounding a needle. As shown in Figure 7 of Parry, a guide track is shown in which a pin travels. The sleeve is rotated to move the pin into the position shown at 218 and then operation of the syringe causes the pin to automatically move along the track while being guided by the fingers. The pin moves through various positions into position 223, in which position the needle may be used to give an injection. To allow the needle to provide the injection, pin moves along guide track 210 longitudinally until coming to rest at location 224. The guide track 210 of Parry does not allow for relative rotational movement between the first and second members 207, 208, respectively. The only relative rotational movement is disclosed in connection with the initial uncovering of the needle during which the pin moves from position 216 to position 218. Therefore, Parry does not teach all the limitations of Claims 1, 2, 4, 9-13, 15, and 19.

With regard to Claims 9-11, these Claims depend from two Claims that the Examiner has rejected under 35 U.S.C. § 103(a). Claims 9-11 depend on Claim 8, which depends on Claim 7. The Examiner rejects Claims 7 and 8 as obvious over Parry and the knowledge of one with ordinary skill in the art. *Office Action, page 6, second full paragraph*. Thus, the Examiner has

failed to show that Claims 9-11 are anticipated by a single reference. Further, if Parry does not teach all the limitations of a base claim (Claim 7) and an intervening claim (Claim 8), Parry cannot teach all the limitations of the dependent claims (Claims 9-11).

It is therefore respectfully requested that this rejection be withdrawn.

**VI. Rejection of Claims 5 and 6-8 under 35 U.S.C. § 103(a)**

The Examiner has rejected Claims 5 and 6-8 under 35 U.S.C. § 103(a) as being unpatentable over Parry.

To “establish a *prima facie* case of obviousness of a claimed invention, there must be a suggestion or motivation to modify the references, ... and all claim limitations must be taught in the prior art.” *MPEP 2143*.

For the reasons set forth in Section V. of this Amendment and Response, it is respectfully submitted that the cited references do not teach all the limitations of Claims 5 and 6-8. It is therefore respectfully requested that this rejection be withdrawn.

**VII. Rejection of Claim 3 under 35 U.S.C. § 103(a)**

The Examiner has rejected Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Parry in view of U.S. Patent No. 5,019,051 (“Hake”).

As set forth in Section V. of this Amendment and Response, Parry fails to teach a second guide part operative on movement by the manual relative rotation of the first and second members. Further, Hake does not teach the limitations missing from Parry. It is respectfully submitted that the cited references do not teach all the limitations of Claims 5 and 6-8. It is therefore respectfully requested that this rejection be withdrawn.

**VIII. Rejection of Claim 14 under 35 U.S.C. § 103(a)**

The Examiner has rejected Claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Parry in view of U.S. Patent No. 5,306,258 (“de la Fuente”).

As set forth in Section V. of this Amendment and Response, Parry fails to teach a second guide part operative on movement by the manual relative rotation of the first and second members. Further, de la Fuente does not teach the limitations missing from Parry. It is therefore respectfully requested that this rejection be withdrawn.

**IX. Rejection of Claims 20 and 21 under 35 U.S.C. § 103(a)**

The Examiner has rejected Claims 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Parry in view of U.S. Patent No. 5,536,257 ("Byrne").

As set forth in Section V. of this Amendment and Response, Parry fails to teach a second guide part operative on movement by the manual relative rotation of the first and second members. Further, Byrne does not teach the limitations missing from Parry. It is therefore respectfully requested that this rejection be withdrawn.

**X. Objection to Claims 16-18 as Dependent on a Rejected Base Claim**

The Examiner has objected to Claims 16-18 as being dependent on a rejected base claim and that these Claims would be allowable if rewritten in independent form including all the limitations of the base claim.

As asserted above, base Claim 15 is not anticipated by Parry. Thus, Claims 16-18 do not depend from a rejected base claim. It is therefore respectfully requested that the objection to Claims 16-18 be withdrawn.

### CONCLUSIONS

In view of the remarks set forth in this Amendment and Response to Office Action, it is respectfully submitted that the Pending Application, including Claims 1-21, is in condition for allowance. Therefore, it is respectfully requested that the foregoing amendments and responses be entered, and the Pending Application be promptly allowed.

The Examiner is invited to contact the undersigned if such contact would in any way facilitate and expedite the prosecution of this application.

Respectfully submitted,

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Susan D. Reinecke, Reg. No. 40,198  
Michael Best & Friedrich LLC  
401 N. Michigan Ave., Suite 1900  
Chicago, IL 60611  
(312) 222-0800